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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,779	06/28/2007	Thienna Ho	70063.00004	4440

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EXAMINER	
YU, GINA C	

ART UNIT	PAPER NUMBER
1611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,779	HO, THIENNA	
	Examiner	Art Unit	
	GINA C. YU	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-6,9-11,13,15,17 and 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-6,9-11,13,15,17 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of amendment filed on February 5, 2010. No claim amendment has been made.

Claim rejection made under 35 U.S.C. § 112, first paragraph as indicated in the previous Office action dated January 29, 2010 has been withdrawn in view of the applicant's remarks.

Claim rejection made under 35 U.S.C. § 103 (a) indicated in the same Office action is maintained for reasons of record.

Claim Rejections - 35 USC § 103 (Maintained)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4-6, 9-11, 13, 15, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herschler (US 4296130) in view of Webster's Ninth New Collegiate Dictionary (1991) and Salim (WO 94/05279).

Herschler teaches MSM can be included in a cosmetic or other preparations applied to the skin, and beautifies the complexion, improves the condition of the scalp and hair and help to make the body of the user more flexible and comfortable. The reference also teaches MSM can be administered orally. See col. 2, lines 18 – 46. The reference teaches MSM is inert to the chemistry of the body.

Webster teaches the term "complexion" of skin refers to the hue or appearance especially of the face, as in "a dark complexion". See p. 269, second col. complexion. The usage of the term to denote skin tone is also seen in applicant's specification, p. 5,

second paragraph, "a daily maintenance of facial skin tone, that is, to maintain a lighter facial complexion after a desired amount of skin lightening has already been achieved".

Herschler does not teach the dosage of MSM oral administration as required by the present claim.

Salim teaches a method of treating and improving skin condition by administering methyl sulfonyl methane and a sulfur-containing amino acid. The reference teaches the composition may be administered topically, orally or parenterally. See p. 7, first paragraph. The reference teaches the oral dosage unit contains from 100-500 mg of each of methyl sulfonyl methane and amino acid, and given once or more daily at intervals of from 2-8 hours, most preferably every 6 hours (e.g., 300-1,500 mg taken thrice daily at 6 hour interval or more at 2 hour interval). The reference also teaches topical administration comprising at least 0.5 % w/w of each of the active ingredients, preferably 5 % methyl sulfonyl methane and 2 % cysteine or methionine. See p. 5, first full paragraph. The reference teaches the improvements in skin condition includes combating aging of skin, protection against environment, providing sunscreening effects, enhancing the healing of wounds, inflammation, fissures, and maintenance of its vitality, smoothness, firmness and texture. See p. 3, bridging paragraph. The reference indicates , for example, a topical formulation of Example 1.D were applied twice daily for 6 months then once daily for 18 months, resulting in significant improvement in the skin's smoothness, firmness, and wrinkle reduction. See p. 18, second full par.

It would have been obvious to one of ordinary skill in the art at the time of the present invention that the Herschler method of administering MSM to human subjects

would bring about changes to, and/or improve, the color and skin tone and/or overall appearance of the skin because the reference teaches MSM "beautifies complexion" of the skin, and the Webster dictionary indicates that complexion refers to the color or appearance of skin in cosmetic art. Thus applicant's claim of development of "a skin tone noticeably lighter than the person's natural skin tone" by administering MSM to the patient would naturally flow from practicing the Herschler method, which would have been obviously observed by one of ordinary skill in the art.

Furthermore, orally administering MSM with the amount and dosage within the present claim limitation would have been also obvious in view of the teachings of Salim because 1) Herschler teaches MSM is nontoxic and inert to the chemistry of the body; and 2) Salim provides general teachings of the oral dosage of MSM to obtain cosmetic effects. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this case, Herschler teaches administration of MSM beautifies complexion of the skin and Salim teaches 1,500 mg of MSM may be orally taken thrice daily at 6 hour interval or more at a more frequent interval to obtain various skin conditioning benefits. Thus the prior arts sufficiently provide conditions of the presently claimed invention for a skilled artisan to work with, and discover the optimum or workable ranges by routine experimentations. In view of the combined teachings of

the references, the present claims are viewed an obvious variation of the prior art use of MSM to improve skin complexion.

Oath/Declaration

Two declaration filed under 36 C.F.R. § 1.132 on February 9, 2010 have been fully considered but do not place the application in allowable condition.

Declarants state that a person of ordinary skill in the art would not have used the phrase in the Herschler "beautify the complexion" to mean lightening skin color. However, such interpretation is not the basis of the present obviousness rejection. Cosmetic art encompasses both skin lightening method as well as self-tanning method, and thus what would amount to beautified complexion is a subjective issue. Although the term "beautify" is a relevant term of degree and not an objective term, the term "complexion" is. The term "complexion" in cosmetic art has been unambiguously used to mean skin tone and color, as applicant herself also has used in specification. An objective conclusion which can be drawn from the prior art teaching is that administration of MSM changes skin color of the patient in one way or the other, and one of ordinary skill in the art would have observed what that change is. Therefore, examiner maintains the position that given Herschler it would have only taken ordinary skill in cosmetic art to manipulate the dosage of MSM to improve skin condition to change skin tone.

Declarants also argue that Herschler at the time of the prior art could not have published a statement showing a preference to lighter skin as such remarks would have

offended readers in public. In response, such assertion is based on retrospective speculation at best.

A more relevant issue is what the prior art would have taught, suggested, or motivated a person of ordinary skill in the art. A person of ordinary skill in cosmetic art was well aware that skin lightening methods and whitening products were nevertheless high in demand and aggressive marketed in many countries including the United States. See Timmons, "Telling India's modern women they have power, even over their skin tone", The New York Times (May 30, 2007, pg. C5; abstract. The article teaches that the ads for skin whitening products in the United States have been intentionally changed as spot or blemishes removers during 1970's and 1980's, indicating that a person of ordinary skill in cosmetic art nevertheless knew these products were used for whitening skin and consumers used such for the actual skin lightening effect.

Examiner is not in the position to read a prior art only from a view which public would consider more appropriate at the time, as such limited interpretation itself would inject bias. The issue in this case is what a person of ordinary skill in the art knew at the time of the invention. According to the Timmons article and applicant's own disclosure, a person of ordinary skill knew skin lightening products and methods have been and remain popular in cosmetic industry. Therefore, declarants' argument that a person of ordinary skill in the cosmetic art would have ignored possible implication of the expression "beautify skin complexion" is not convincing.

Response to Arguments

Applicant's arguments filed on February 5, 2010 have been fully considered but they are not persuasive.

Rejection under 35 U.S.C. § 103 (a)

Applicant asserts the testimony of the declarant support's applicant's position that the meaning of the phrase "beatify the complexion" is limited to providing the skin a softer, smoother texture and appearance only. However, such limited interpretation of the phrase could not have been reached unless a person of ordinary skill in the art to intentionally ignored the meaning of the term "complexion". Doing so would not be an objective reading of the prior art, particularly when applicant's own use of the term "complexion" in specification indicates as a person of ordinary skill in the art applicant knew the term refers to skin color and tone.

Applicant also asserts a skilled artisan would not have been motivated to increase the prior art MSM dosage because the decreased amount was already known to be effective for all known cosmetic and therapeutic applications. Applicant asserts there is no suggestion that higher doses of MSM would produce any beneficial effect. However, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is well settled that determining the optimal value of a result-affecting

variable is normally obvious, unless the claimed process condition produces an unexpected result. See Pfizer Inc. v. Apotex Inc., 480 F.3d 1348, 1368-69 (Fed. Cir. 2007). In this case, examiner is of opinion that changes of skin color and tone by MSM administration is taught and suggested by Herschler and an expected result. Given such knowledge, manipulating the dosage to achieve the optimal result would have taken ordinary skill in the art.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/
Primary Examiner, Art Unit 1611